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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,621

Applicant(s)

MILLIORN ET AL.

Examiner

Walter B Aughenbaugh

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,12-18,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12-18,21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made to claims 5, 9, 12, 14, 15, 18 and 23 made on pages 1-2 and 11-12 of Applicant's Amendment (Paper #6) have been received and considered by Examiner.
2. Applicant's cancellation of claims 8, 11, 19, 20, 22 and 24-28 in Applicant's Amendment (Paper #6) has been acknowledged by Examiner.

WITHDRAWN OBJECTIONS

3. The objection to the specification made of record in page 3, paragraph 6 of Paper #5 has been withdrawn due to Applicant's argument and citation of MPEP § 608.01 in made in Paper #6.

WITHDRAWN REJECTIONS

4. The 35 U.S.C. 112 rejection of claims 8, 11, 19, 20 and 22 made of record in pages 3-4, paragraph 8 of Paper #5 has been withdrawn due to Applicant's cancellation of claims 8, 11, 19, 20 and 22.
5. The 35 U.S.C. 112 rejection of claims 1, 3, 5, 9, 12, 14-16, 18 and 23 made of record in pages 3-4, paragraph 8 of Paper #5 has been withdrawn due to Applicant's arguments (in the case of claims 1, 3, 15 and 16) and/or amendments (in the case of claims 5, 9, 12, 14, 15, 18 and 23) in Paper #6.
6. The 35 U.S.C. 103 rejection of claims 15-18 over Oosterlinck in view of Warther and in further view of Kirk made of record in pages 7-8, paragraph 11 of Paper #5, has been withdrawn due to Applicant's amendments in Paper #6.

REPEATED REJECTIONS

7. The 35 U.S.C. 103 rejection of claims 1-7 over Oosterlinck in view of Warther is repeated for the reasons previously of record in pages 5-7, paragraph 10 of Paper #5.

8. The 35 U.S.C. 103 rejection of claims 9, 21 and 23 over Oosterlinck in view of Warther and in further view of Kirk and in further view of admitted prior art of Applicants is repeated for the reasons previously of record in pages 8-10, paragraph 12 of Paper #5.

9. The 35 U.S.C. 103 rejection of claims 10 and 12 over Oosterlinck in view of Warther and in further view of admitted prior art of Applicants is repeated for the reasons previously of record in page 10, paragraph 13 of Paper #5.

10. The 35 U.S.C. 103 rejection of claims 13 and 14 over Oosterlinck in view of Warther and in further view of admitted prior art of Applicants is repeated for the reasons previously of record in pages 10-11, paragraph 15 of Paper #5.

NEW REJECTIONS

11. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oosterlinck in view of Warther and in further view of Kirk and in further view of admitted prior art of Applicants (specification, page 1, paragraph [0003]).

In regard to claims 15-18, Oosterlinck, Warther and Kirk teach the triangular shaped label as discussed in pages 5-7, paragraph 10 of Paper #5 and pages 7-8, paragraph 11 of Paper #5. Since cancelled claim 20 has been incorporated into claim 15, the new amendment necessitated the new rejection to claims 15-18.

Oosterlinck, Warther and Kirk fail to teach that the triangular shaped label has sides of equal length, and also fail to teach that the face material includes text selected from a group

Art Unit: 1772

consisting of text found in day of the week first in first out food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems.

However, in regard to the limitation that the triangular shaped label has sides of equal length, since Warther teaches configuration of the labels on a sheet so as to maximize the number of tag elements which may be provided on a sheet product of a given size, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the labels of Warther so that the sides of the triangular shaped label are of equal length in order to further maximize the number of tag elements which may be provided on a sheet product of a given size. For example, modification of the length of the sides of labels in the form of tags 50A-50X of Warther such that each of the sides are the length of the shortest side of tags 50A-50X of Warther would allow for a fourth row of labels in sheet 110 in Figure 3.

However, in regard to the claimed group of types of text, Applicants disclose that these three food safety labeling systems are notoriously well known to those of ordinary skill in the food safety labeling art in paragraph [0003] of the "Background of the Invention" section of Applicants' specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided text consisting of text found in day of the week first in first out food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems to the label of Oosterlinck, Warther and Kirk since it is notoriously well known to provide text consisting of text used in the aforementioned food safety labeling systems as taught by the admission of Applicants.

ANSWERS TO APPLICANTS ARGUMENTS

12. Since cancelled claim 20 has been incorporated into claim 15, the new amendment necessitated the new rejection to claims 15-18.

13. Applicant's arguments on pages 5-7 of Paper #6 regarding the 35 U.S.C. 103 rejection of claims 1-7 over Oosterlinck in view of Warther (Paper #5, paragraph 10) have been fully considered but they are not persuasive.

In response to Applicant's argument in the second full paragraph of page 6 through the third full paragraph of page 7 of Paper #6 that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). One of ordinary skill in the art would have been motivated to have consulted Warther for the teaching of Warther as how to maximize the number of elements (such as the labels of Oosterlinck) which may be provided on a sheet product of a given size via control of the geometry of the elements and the relationship between the elements on the sheet because both Oosterlinck and Warther are concerned with a particular arrangement of elements (labels in the case of Oosterlinck and labels and tags in the case of Warther) within an identifying element(label or tag)/adhesive layer/backing layer system, where

Art Unit: 1772

Warther teaches an element geometry and arrangement that is more efficient from space conservation and economical view points. The arrangement of the triangular shaped tags taught by Warther would suggest to one versed in the art to form the labels of Oosterlinck in the triangular shape of the tags of Warther and to arrange the resultant triangular shaped labels such that the first side of adjacent labels face each other and the second side of adjacent labels face each other such that the third side of each label faces outwardly from the web width in order to maximize the number of elements which may be provided on a sheet product of a given size as taught by Warther, as previously made of record in paragraph 10 of Paper #5.

In response to Applicant's first reason why there is no motivation to combine the references, which is a summary of the inventions of Oosterlinck and Warther, Applicant suggests that since Warther teaches a "printed sheet product (tags or labels) formed by a core of printable sheet material having a pair of opposing major planar sides in which each side can contain printing" and since Oosterlinck teaches "labels that have printing on one side and an adhesive layer on the other side", the references cannot be combined. Note that both of the opposing major planar sides (transparent layers 20 and 22) *can* contain printing, but the condition that both of the opposing major planar sides contains printing is not required. While Warther does indeed teach a "printed sheet product (tags or labels) formed by a core of printable sheet material having a pair of opposing major planar sides in which each side can contain printing", Warther also teaches an adhesive layer formed on the labels (item 64, Figure 2) and also on one of the opposing major planar sides of the tags (transparent layers 20 and 22) that Applicants refer to (col. 9, lines 47-57). Therefore, Oosterlinck and Warther both teach the same structure of a printable sheet material adjacent to an adhesive layer, and as such one of ordinary skill in the art

Art Unit: 1772

would have been motivated to combine the references. The fact that the label of Oosterlinck is “used for labeling bottles, jars, and other containers and articles” is irrelevant since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). Furthermore, one of ordinary skill in the art would have recognized that the labels of Warther could be used for the same intended use as those of Oosterlinck.

Applicant’s second reason why there is no motivation to combine the references, which is an assertion that “neither the tags or labels of Warther are formed from face web, an adhesive layer and a backing layer” is incorrect. The labels of Warther are formed from face web (a laminate of layers 20, 12 and 22), an adhesive layer (item 64) and a backing layer (item 66) of release material. Furthermore, the tags of Warther are formed from face web (a laminate of layers 20, 12 and 22), an adhesive layer, and a backing layer (magnetic stripe, items 31-34) (col. 9, lines 47-57 and col. 10, lines 9-16). Contrary to Applicant’s assertion that “only strips of pressure sensitive adhesive and release material are attached to the ends or sides of each label” the entirety of one side of the labels of Warther (items 60A-60P) are backed with pressure sensitive adhesive (item 64) and release material (item 66) (see Figure 2). Furthermore, in response to Applicant’s piecemeal analysis of the Warther, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). The printable material/adhesive layer/backing layer structure is clearly established in both Oosterlinck and Warther. Applicant’s assertion that combining the references “would destroy the functionality of

Art Unit: 1772

the Warther tags and labels” is irrelevant since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations.

Applicant’s assertion that the problem solved by Oosterlinck “does not apply to Applicant’s labels as its labels are not pulled through or associated with an automated label application machinery” is also irrelevant since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations.

In response to Applicant’s comparison of the methods used to form the respective labels of Oosterlinck and Warther in the third full paragraph of page 7, the method of forming the label is not germane to the issue of patentability of the label itself. The determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. Applicant’s assertion that “the tags or labels [of Warther] are not even formed from label stock that includes a face web, an adhesive layer and a backing liner” is incorrect, as previously discussed on page 7 of this Office Action (Paper #7).

14. Applicant’s arguments on pages 7-9 of Paper #6 regarding the 35 U.S.C. 103 rejection of claims 8-23 over the various combinations of references made of record in paragraphs 11-14 (pages 7-11) of Paper #5 have been fully considered but they are not persuasive.

Art Unit: 1772

Applicant's arguments against these rejections depend entirely on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 over Oosterlinck in view of Warther (Paper #5, paragraph 10), which have been addressed in paragraph 12 of this Office Action (Paper #7).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 4,680,210 to Corcoran.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

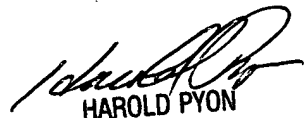
Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
03/31/03

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/7/03